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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No.: 75/914,792

Mark: WHERE SMART MONEY MEETS BREAKTHROUGH
IDEAS

Filed: February 9, 2000

Published: September 18, 2001



10-17-2001
U.S. Patent & TMO/TM Mail Rpt Dt. #71

BENEFICIAL FRANCHISE COMPANY,
INC.

Opposer,

Opposition No. _____

v.

COMDAQ CORPORATION,

Applicant.

NOTICE OF OPPOSITION

Beneficial Franchise Company, Inc. ("Opposer"), a Delaware corporation, having an office at 400 Bellevue Parkway, Wilmington, Delaware 19809, believes it will be damaged by registration of the mark "WHERE SMART MONEY MEETS BREAKTHROUGH IDEAS" as shown in Applicant's trademark application, Serial No. 75/914,792, filed February 9, 2000 and published September 18, 2001 for providing financial information, namely, providing information about the assets of privately held businesses prior to an initial public offering by means of a global computer network.

The following are the grounds upon which this opposition is based:

10/24/2001 KGIBBONS 00000107 011944 75914792

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1. On September 9, 1997, Opposer was granted a registration for the mark SMART MONEY, Registration No. 2,095,401, by the United States Patent and Trademark Office. A certified copy of Opposer's registration is attached hereto. Opposer had applied for the mark on March 14, 1991, under Serial No. 74/147,660, for interactive computer programs for educational use, and instructional manuals sold therewith.

2. Opposer's first use of the mark SMART MONEY was in September, 1991, and the first use in interstate commerce was also in September, 1991. The mark has been in use since that time. The software in connection with which the Opposer's mark is used to provide instruction in personal finance, including banking, budgeting, investment, money management and other personal finance topics.

3. The ComDAQ Corporation, a Texas corporation with a place of business located at 7626 Parkview Circle, Austin, Texas, filed with the USPTO an intent-to-use application for the mark WHERE SMART MONEY MEETS BREAKTHROUGH IDEAS for providing financial information, namely, providing information about the assets of privately held businesses prior to an initial public offering by means of a global computer network.

4. Applicant's mark WHERE SMART MONEY MEETS BREAKTHROUGH IDEAS incorporates Opposer's mark SMART MONEY in its entirety. Applicant's use of the mark WHERE SMART MONEY MEETS BREAKTHROUGH IDEAS creates a commercial impression that is confusingly similar to the commercial impression engendered by Opposer's mark. In light of such similarity of the marks, confusion between them is likely.

5. The addition of the words WHERE and MEETS

BREAKTHROUGH IDEAS in Applicant's mark do not diminish the confusing similarity between the two marks. The subject portion of that mark, "SMART MONEY," is the more dominant portion of the mark, while the predicate, "MEETS BREAKTHROUGH IDEAS," is less dominant.

6. Applicant's mark allegedly will be used in connection with

financial, banking, lending, credit and investment related services provided by means of a computer network to computer users. Opposer has used and uses its registered mark SMART MONEY specifically in conjunction with computer software designed to educate and provide information to consumers and potential consumers of financial products and services, banking, lending, credit and investment services. Due to the relatedness of goods and services provided by both Opposer and Applicant, confusion between Opposer's registered mark and Applicant's mark is likely.

7. By virtue of Opposer's and its related companies' efforts and the

expenditure of considerable sums for promotional activities, Opposer and its related companies have become well-known in the banking and financial industries. Applicant's use of a mark which is similar to Opposer's registered mark SMART MONEY for goods and services which will be offered in the same channels of trade to the same consumers and potential consumers as those of Opposer's goods will be very likely to cause confusion among Opposer's customers and among those familiar with Opposer and its related companies.

8. Opposer filed its application for registration of its mark on March 14, 1991. Applicant's intent-to-use application was not filed until May 1, 2000. Clearly, Opposer has priority of rights to the mark SMART MONEY as against Applicant.

9. In light of the above, it is alleged that Applicant's mark is likely to cause confusion, or to cause mistake or to deceive. Persons familiar with Opposer's registered mark will be likely to believe that Applicant's products or services originate with or are sponsored by Opposer. Any such confusion in trade will seriously injure Opposer to the extent that any defect, objection, or fault found with Applicant's products or services which will be marketed under its mark has and would necessarily reflect upon the reputation which the Opposer has and will establish for its products merchandised under its registered mark. Similarly, those persons who become familiar with Applicant's mark will be likely to believe that Opposer's products and services originate with Applicant. Any such confusion in trade will seriously injure Opposer to the extent that the goodwill engendered through its goods and services under its SMART MONEY mark is attributed to Applicant.

10. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

WHEREFORE, Opposer requests that this opposition be sustained and that the Application Serial No. 75/914,792 by Applicant be refused.

A duplicate copy of this Notice of Opposition is enclosed herewith.

FEES

Please charge the filing fee in connection with this Notice of Opposition to our firm's Deposit Account No. 01-1944.

Respectfully submitted,
ANDERSON KILL & OLICK, P.C.

By: 

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BENEFICIAL FRANCHISE
COMPANY, INC.

Date: October 17, 2001

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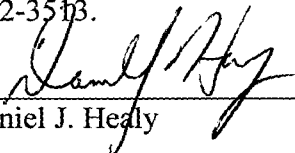
Applicant.

CERTIFICATE OF MAILING

Express Mail No.: E1763936812US

Date: October 17, 2001

I hereby certify that the NOTICE OF OPPOSITION and Exhibit in the above-identified proceeding is being deposited in duplicate with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 and is addressed to the Commissioner for Patents and Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513.



Daniel J. Healy



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

October 02, 2001

THE ATTACHED U.S. TRADEMARK REGISTRATION 2,095,401 IS
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH
REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 10 YEARS FROM *September 09, 1997*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

W. Montgomery
W. MONTGOMERY
Certifying Officer

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,095,401

United States Patent and Trademark Office

Registered Sep. 9, 1997

**TRADEMARK
PRINCIPAL REGISTER**

SMART MONEY

**BENEFICIAL FRANCHISE COMPANY, INC.
(DELAWARE CORPORATION)
400 BELLEVUE PARKWAY
WILMINGTON, DE 19809**

**THEREWITH, IN CLASS 9 (U.S. CLS. 21, 23, 26,
36 AND 38).**

**FIRST USE 9-0-1991; IN COMMERCE
9-0-1991.**

**FOR: INTERACTIVE COMPUTER PRO-
GRAMS FOR EDUCATIONAL USE, AND IN-
STRUCTIONAL MANUALS SOLD AS A UNIT**

SN 74-147,660, FILED 3-14-1991.

IRA J. GOODSaid, EXAMINING ATTORNEY